



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,173	08/01/2001	James K. Lacy	31660	5297

27910 7590 12/09/2004

STINSON MORRISON HECKER LLP
ATTN: PATENT GROUP
1201 WALNUT STREET, SUITE 2800
KANSAS CITY, MO 64106-2150

[REDACTED] EXAMINER

ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/920,173	LACY, JAMES K.
	Examiner	Art Unit
	Mitra Aryanpour	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 07 September 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 42-82 is/are pending in the application.
 4a) Of the above claim(s) 74-82 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 42-73 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

1. Claims 74-82 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 02 September 2004.

Claim Objections

2. Claim 45 is objected to because of the following informalities: There is insufficient antecedent basis for the limitation "said backboard" in line 1 of the claim. It appears that claim 45 should be dependent on claim 43. Appropriate correction is required for the above objection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 42, 44, 46, 47, 50, 52, 54, 56, 58 and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Burtch (5,465,961).

Regarding claim 42, Burtch discloses a game that substantially mimics an aspect of a sport, the game comprising: a drinking beverage bottle such as a beverage bottle or other such beverage container (A), a catsup bottle or other food/condiment container, a drink cup or glass, food bowl or other items having upstanding or other projecting rim portion (see column 2, lines 1-10); and a scoring structure (hoop 14a) removably coupled to an upper portion of said bottle (A) to thereby position the scoring structure for play, wherein said scoring structure is a basketball goal (see figures 4) or football goal (U-shaped element 34; see figures 5 to 9).

Regarding claim 44, Burtch additionally shows a shot ramp (the broadest reasonable interpretation of shot ramp would include the launching device formed by components 26 and 28).

Regarding claim 46, Burtch shows the game additionally comprises a retaining clip (mounting portion 14b and/or mounting elements 36 and 38) configured to removably couple said scoring structure to an open bottle (see figures 4 and 8).

Regarding claim 47, note the rejection of claim 46. additionally, it should be noted that the beverage bottle or containers all come with a lid or cap. The bottles and/or containers can be used with or without the lid or cap.

Regarding claim 50, Burtch shows a circular shot ring (the broadest reasonable interpretation of shot ring would include circular opening 28b).

Regarding claim 52, Burtch shows the scoring structure is a football goal comprising a cross bar, a left and right upright (U-shaped element 34; see figures 8 and 9).

Regarding claim 54, Burtch further shows the football goal additionally comprises a kicking tee (the broadest reasonable interpretation of kicking tee would include the pair of launcher elements 42 and 44; see figures 6 and 9) adapted to support a ball in a kicking position for launching a ball toward said scoring structure.

Regarding claim 56, note the rejection of claim 42.

Regarding claim 58, note the rejection of claim 44.

Regarding claim 64, note the rejection of claim 52.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 42-47, 52-54, 56-60, 64-66, 68, 71-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong (5,752,703) in view of Burtch (5,465,961).

Regarding claim 42, Wong shows a game that substantially mimics an aspect of a sport (in the instant case basketball or football) the game comprising: a scoring structure (the combination of the backboard 18 and rim 14) configured and adapted to be coupled to an upper portion of a cup to thereby position the scoring structure for play. The scoring structure of Wong as best seen in figures 1 and 3 is attached to a cup. With regards to the scoring structure being removably coupled, the backboard/ramp (16) is removably attached to the rim (14). It should be noted the broadest reasonable interpretation of a bottle would include the cup shown by Wong, Nevertheless for the sake of argument Burtch shows a game that substantially mimics an aspect of a sport, the game comprising: a drinking beverage bottle such as a beverage bottle or other such beverage container (A), a catsup bottle or other food/condiment container, a drink cup or glass, food bowl or other items having upstanding or other projecting rim portion (see column 2, lines 1-10); and a scoring structure (hoop 14a) removably coupled to an upper portion of said bottle (A) to thereby position the scoring structure for play, wherein said scoring structure is a basketball goal (see figures 4) or football goal (U-shaped element 34; see figures 5 to 9). In view of Burtch it would have been obvious to utilize any container including a

Art Unit: 3711

beverage bottle for use with Wong's game, the motivation being to create a game that is entertaining to play and which has a particular appeal to customers at a sport's bar or like establishments.

Regarding claim 43, Wong shows the scoring structure comprises: a backboard (16) adapted to be supported in a substantially vertical position when the scoring structure is removably coupled with a bottle or any other support structure; and a basket rim (14) secured to the backboard and adapted to be supported in a substantially horizontal position (see figure 1) when the scoring structure is removably coupled to a bottle or any other support structure such that a ball (46) may pass through the basket rim (14).

Regarding claim 44, Wong shows the game additionally comprises a shot ramp (see column 1, lines 45-52; also column 3, lines 41-44) adapted to launch a ball (46) toward the scoring structure (see figures 1 and 3).

Regarding claim 45, Wong shows the ramp to be a board (16), but is silent with regards to the use of a coaster to form a ramp. The broadest reasonable interpretation of a coaster would include Wong's board (16) when not used as a target game.

Regarding claim 46, Wong shows the game additionally comprises a retaining clip (20 in figure 1 and 36 in figure 3; best seen in figure 5) configured to removably couple the scoring structure to an open bottle. The broadest reasonable interpretation of a clip would include the tab as shown and described by Wong.

Regarding claim 47, Wong alone and as modified in view of Burtch show a retaining clip (note the comments for claim 46). However Wong as modified above is silent with regards to the support structure having a lid. As it is well known the lid is an optional feature that comes

with cups and/or beverage bottles, to further utilize the lid or cap of the cup and or bottle when playing a game is considered an optional matter of design choice. In the instant case it would also allow the game device of Wong to be used as a rebounding surface.

Regarding claim 52, Wong shows the scoring structure is a football goal comprising a cross bar, a left upright and a right upright (see figure 1; also column 3, lines 28-35).

Regarding claim 53, Wong shows the football goal additionally comprises a goal post, which is part of the game board and it is adapted to be removably coupled to the support cup (see figure 1). With regards to the support being a bottle see the comments for claim 1.

Regarding claim 54, Wong shows the game additionally comprises a kicking tee (50) adapted to support a ball (46) in a kicking position for launching a ball (46) toward the scoring structure.

Regarding claim 56, see the comments for claim 42.

Regarding claim 57, see the comments for claim 43.

Regarding claim 58, see the comments for claim 44.

Regarding claim 59, see the comments for claim 45.

Regarding claim 60, see the comments for claim 46.

Regarding claim 64, see the comments for claim 52.

Regarding claim 65, see the comments for claim 53.

Regarding claim 66, see the comments for claim 54.

Regarding claim 68, see the comments for claims 42 and 43

Regarding claim 71, note the rejection of claim 46.

Regarding claim 72, see the comments for claims 1 and 52.

Art Unit: 3711

Regarding claim 73, see the comments for claim 53.

7. Claims 55, 67 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim, 42, 56 and 68, and further in view of Davey, III (6,116,605).

Regarding claim 55, Wong provides a target game for placement on a tabletop. Wong does not expressly indicate that a magnet can be utilized for securing the scoring structure to a surface. Various means are well known in the game art for aiding attachment of a game apparatus to a support surface e.g. clips, suction cups, screws, nuts & bolts or magnets. Davey, III shows such an attachment. Davey, III shows a magnetic sports-toss game, wherein the target frame (34) is magnetically attached to a surface (1). In view of Davey, III, it would have been obvious to one having ordinary skill in the art to have included an attachment means within the Wong reference, the motivation being so that the target game can also be utilized in an area, other than just the tabletop.

Regarding claim 67, note the rejection of claim 55.

Regarding claim 70, note the rejection of claim 55.

8. Claims 48, 51, 57, 61-63, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burtch (5,465,961) in view of Williams (2,889,149).

Regarding claim 48, Burtch does not disclose expressly the use of a deflector in combination with the basketball game. Williams shows a game that substantially mimics an aspect of the sport of basketball comprising: a backboard (47) providing a surface for deflecting a ball; a coupling member (23, 26) configured to couple the backboard to an upper portion of a support structure (11) in a substantially vertical orientation; a basket rim coupled to the backboard (47), and an adjustable ball deflector (deflector 48 or alternatively eccentric deflector

Art Unit: 3711

58). In view of Williams it would have been obvious to also include a deflector for the game of Burtch, the motivation being in order to direct the ball on a single controlled bounce to a desired position.

Regarding claim 51, Burtch also does not show the basket rim (14a) to include a tubular net. Williams additionally shows the basket rim including a tubular net (16 or 46; see figures 3 and 4). In view of Williams it would have been obvious to also include a tubular net for the basket rim of Burtch, the motivation being in order to more realistically mimic the game of basketball. In view of Williams it would have been obvious to also include a tubular net for the basket rim of Burtch, the motivation being in order to more realistically mimic the game of basketball.

Regarding claim 57, Burtch as disclosed above does not expressly disclose the inclusion of a backboard. Williams additionally shows a basket rim coupled to the backboard (47).

Regarding claim 61, Burtch as modified in view of Williams additionally shows the ball deflector (deflector 48 or alternatively eccentric deflector 58) is adjustably attached to the support (see figures 1-4).

Regarding claim 62, Burtch as modified above show the deflector to comprise a cardboard drink coaster. It should be noted that Burtch shows a novelty game card which includes punch-out components made from paperboard or cardboard. Therefore, when modified to include a ball deflector, the deflector would also be made from paperboard or cardboard material that is removably attached to a beverage bottle or container.

Regarding claim 63, note the rejection of claim 50.

Regarding claim 68, note the rejection of claims 56 and 57.

Regarding claim 69, note the rejection of claim 62.

Response to Arguments

9. Applicant's arguments with respect to claims 42-73 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
03 December 2004



MITRA ARYANPOUR
PATENT EXAMINER